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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,175	09/30/2003	Paul Anthony Rhea	60046.0025US01	5911
53377	7590	05/22/2006	EXAMINER	
HOPE BALDAUFF HARTMAN, LLC			RIAD, AMINE	
P.O. BOX 2825			ART UNIT	
ATLANTA, GA 30301			PAPER NUMBER	

2113

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,175

Applicant(s)

RHEA ET AL.

Examiner

Amine Riad

Art Unit

2113

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/29/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12, 14-18 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 13 and 19 is/are rejected.
- 7) ☐ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *AR*
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) *AR*
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed action

Claims 1-20 have been presented for examination.

Claims 1-4, 7, 8, 13, 14, 19 and 20 have been rejected.

Claims 5 and 6 are objected to.

Claims 9-12 and 15-18 are allowed.

Objection

Claims 7, 8, 13, 14, 19 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claim 16, **the method of claim 5** needs to be changed to **the method of claim 15**.

Claim 16 needs to be changed because it is more related to claim 15. It appears that it is a typing error.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7, 8, 13, 14, 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to claims 7, 13, and 19,

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Claims 7, 13 and 19 are not limited to tangible embodiments. In view of applicant's disclosure [specification page 6; line 21], the computer readable medium is not limited to tangible embodiments, instead being defined as including both tangible embodiment for example [solid-state memories, optical and magnetic disks] and intangible embodiments for example [carrier wave signals]. As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

In regard to claims 8,14 and 20,

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

In summary, Claims 8, 14 and 20 recite a computer-controlled apparatus. The recited invention is computer software *per se*. A computer program is merely a set of instructions capable of being executed by a computer. The computer program itself is not a statutory process in that it does not include the computer-readable medium needed to realize the functionality of the computer program. Thus, as currently recited, Claims 8, 14 and 20 is directed to an abstract idea that does not produce a concrete, useful and tangible result.

Examiner notes: in claims 14 and 20 the language capable of needs to be changed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Keyes US Patent 6,516,427.

In regard to claims 1,7 and 8,

Keyes discloses a method for providing and executing a diagnostics module in direct response to a user request (The service person in figure 1 is considered the user of item 12), the method comprising:

- storing at a client computer a control object operative to retrieve the diagnostics module in response to the user request, (Figure 1; item 24 [in (Column 3; lines 47-48) Keyes discloses an event registration and detection routine (Item 24) which is a general purpose computing software/firmware module that functions with CPU 14 to execute diagnostics subroutines]) to store the diagnostics module at the client computer,(Column 4; lines 42-46 [to run a resident diagnostics subroutine means that diagnostics is already stored in the peripheral device considered here as a client computer]) to determine whether execution of the diagnostics module is authorized (Column 4; lines 24-26 [In this passage Keyes discloses that an authorized person registers item 12 with item 34 which means that item 12 would know from where to request diagnostics]) in (Column 4; lines 36-39 [In this passage Keyes adds that since

the HTTP request message is initiated within firewall 32, firewall 32 allows the establishment of the diagnostics execution connection, this is considered as an authorization for diagnostics module execution])and, in response to determining that execution of the diagnostics module is authorized, to execute the diagnostics module. (Column 4; lines 44-46)

Examiner notes: Claim 8 recites a computer- controlled apparatus *capable of* performing the method of claim 1. In Keyes there nothing that precludes from doing the method of claim 1, thus Keyes is capable of doing the method of claim 1.

In regard to claim 2,

Keyes discloses the method of Claim 1, wherein the diagnostics module comprises computer code executable only in response to commands issued by the control object.(Column 4; lines 45-46 [dispatching a request message means sending a command to execute code within the diagnostics subroutine by the JVM])

In regard to claim 3,

Keyes discloses the method of Claim 2, wherein determining whether the execution of the diagnostics module is authorized comprises transmitting a request to a diagnostics server computer for authorization to execute the diagnostics module.(Column 4; lines 31-35 In this passage Keyes sends for a request to execute a diagnostics module. In column 4; lines 38-39 the authorization is determined because the request message I initiated within firewall)

In regard to claim 4,

Keyes discloses the method of Claim 3, wherein retrieving the diagnostics module comprises transmitting a request to the diagnostics server computer for authorization to retrieve the diagnostics module, (Column 4; lines 36-37) receiving authorization to retrieve the diagnostics module, (Column 4; lines 37-39 when firewall initiates the connection it is considered as authorized) transmitting a request to the diagnostics server computer for the diagnostics module in response to receiving the authorization to retrieve the diagnostics module and, receiving the diagnostics module from the diagnostics server computer.(Column 4; lines 42-45)

Allowable Subject Matter

Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

Claims 9-12 and 15-18 are allowed.

The following is an examiner's statement of reasons for allowance:

After a complete search of all the relevant prior art the examiner has determined the claims are in condition for allowance.

Regarding claim 9,

The examiner finds the novel and non-obvious feature of claim 1, when read as whole to be retrieving from the diagnostics server computer a configuration file containing data identifying one or more network addresses at the diagnostics server computer for communicating with the diagnostics server computer and a data file containing data describing how the diagnostics module should be installed on the client computer, requesting, by way of a network address specified by the configuration file, permission to retrieve the diagnostics module from the diagnostics server computer; in response to receiving permission to retrieve the diagnostics module, retrieving the diagnostics module from the diagnostics server computer at a network address specified by the configuration file.

Regarding claim 15,

The examiner finds the novel and non-obvious feature of claim 1, when read as whole to be in response to the selection, retrieving from a diagnostics server computer a configuration file containing data identifying one or more network addresses at the diagnostics server computer for communicating with the diagnostics server computer and a data file containing data describing how the one or more files comprising the diagnostics module should be installed on the client computer; determining, based on the contents of the data file, whether any of the executable files are common to two or more diagnostics modules, in response to determining that one or more of the executable files are common to two or more diagnostics modules, retrieving the common executable files and installing the common executable files on the client computer.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S patent 6,697,969 teaches most of the limitations, but lacks the authorization, on the other hand U.S. patent 6,892,225 contains some elements, but lacks important element, which is the diagnostics element. See PTO 892.


Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amine Riad whose telephone number is 571-272-8185. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR
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